

REMARKS

This communication is filed in response to the Office Action dated May 26, 2010 (hereinafter "Office Action"). Claims 1, 17, 28, and 35-37 are amended. No claims are canceled. No claims are added. Therefore, claims 1-33 and 35-37 remain pending in this application.

Rejection of the Claims Under 35 U.S.C. § 101

The Examiner rejected claim 36 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.¹ In particular, the Examiner asserted:

Claim 36 is directed to a machine-readable medium storing executable instructions that is not limited to a tangible, and thus, statutory medium. The scope of "machine-readable medium" as defined in the specification includes signal-based mediums such as "carrier wave signals" (see Specification, 0353). A signal does not fall within one of the four statutory categories of invention (i.e., process, machine, manufacture, or composition of matter) because it is an ephemeral, transient signal and thus is non-statutory. Since the scope of "computer-readable medium" includes these non-statutory instances, claim(s) is/are directed to nonstatutory subject matter.²

Applicant disagrees with the Examiner's assertion that claim 36 is directed to non-statutory subject matter. Nevertheless, merely to advance the prosecution of this application, Applicant has amended claim 36 to recite "non-transitory." According to instructions issued by the U.S. Patent and Trademark Office (USPTO):

A claim drawn to such a computer readable medium . . . may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation "non-transitory" to the claim.³

The USPTO has instructed that, "[s]uch an amendment would typically not raise the issue of new matter."⁴ Because claim 36 recites "non-transitory," the Examiner's rejection of claim 36 is moot. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. § 101 of claim 36.

¹ Office Action at 2.

² *Id.*

³ USPTO Notice, "Subject Matter Eligibility of Computer Readable Media," issued January 26, 2010.

⁴ *Ibid.*

Rejection of the Claims Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1, 3-5, 7-17, 19-33, and 35-37 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2002/0120577 A1 to Hans et al. (hereinafter “*Hans*”) in view of U.S. Patent Application Publication No. 2004/0193513 A1 to Pruss et al. (hereinafter “*Pruss*”), further in view of U.S. Patent Application Publication No. 2004/0054923 A1 to Seago et al. (hereinafter “*Seago*”).⁵

As discussed in *KSR International Co. v. Teleflex Inc. et al.* (U.S. 2007), the determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence.⁶ The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.⁷

KSR v. Teleflex provides a tripartite test to evaluate obviousness.

The rationale to support a conclusion that a claim would have been obvious is that *all the claimed elements were known* in the prior art and one skilled in the art could have combined the elements as claimed by known methods *with no change in their respective functions*, and *the combination would have yielded nothing more than predictable results* to one of ordinary skill in the art.⁸

Although other rationales for rejection under 35 U.S.C. § 103(a) may exist, the basis for an obviousness rejection is still grounded in a consideration of all claim elements. “All words in a claim must be considered in judging the patentability of that claim against the prior art.”⁹ Additionally, to render the claimed subject matter obvious, the prior art references must teach or

⁵ *Office Action* at 3.

⁶ See *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 7, 1336-37 (Fed. Cir. 2005).

⁷ 383 U.S. 1, 17 (1966).

⁸ See *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007); see also MPEP § 2143, emphasis added.

⁹ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03.

suggest every feature of the claims.¹⁰ Moreover, a prior art reference that “teaches away” from the claimed invention is a significant factor to be considered in determining obviousness.¹¹

Each of independent claims 1, 35, and 37, as amended, recites, in part, performing one or more operations conditionally upon:

there being more than a preset amount of delivery time, the preset amount of delivery time being less than the amount of delivery time available to the content consumer.

In support of an allegation that prior art teaches or suggests a similar recitation (specifically, that “delivery of the content to consumer is conditional upon there being more than a preset amount of delivery time as compared to the stored amount of delivery time available to the content consumer”), the Examiner cited solely to *Pruss* at [0007], [0067], and [0068].¹²

The first paragraph of *Pruss* cited by the Examiner states:

For example, to decide whether to offer, authorize or satisfy requests for new services to users who prepay, mobile service providers need to determine, in real time, such data as customer balance and past service usage. Thus, as a specific example, *to determine whether to permit a particular user having a prepaid account to access a mobile interactive game service, the service provider must be able to determine, in real time, whether the user's account contains sufficient remaining value to cover the requested service.*¹³

Thus, *Pruss* discusses permitting a user to have prepaid account access to a service based on whether a user's account contains sufficient remaining value to cover the service. However, whether there is *sufficient remaining value* in a user's account is not equivalent to whether a *delivery time available to a content consumer* exceeds a preset amount. For example, regardless of whether a user's account has sufficient remaining value, the delivery time available to the user may or may not exceed a preset amount. Furthermore, even if sufficient remaining value was equivalent to delivery time available, which Applicant does not admit, *Pruss* does not teach or suggest that the sufficient remaining value is a *preset value* that is *less than the amount of delivery time available to the content consumer*. Therefore, *Pruss* does not teach or suggest

¹⁰ See Manual of Patent Examining Procedure §§ 706.02(j), 2143(A) (2008); MPEP § 2142 (2006) (citing *In re Vaecck*, 947 F.2d, 488 (Fed. Cir. 1991)). Cited approvingly in *Ex parte WEN WEN* and *PATRICIA NG* at 7; Appeal No. 2009-000776; decided September 25, 2009.

¹¹ See, e.g., *In re Gurley*, 27 F.3d 551, 554 (Fed. Cir. 1994); MPEP § 2145(X)(D)(1).

¹² *Office Action* at 4-5.

¹³ *Pruss* at [0007] (emphasis added).

performing one or more operations conditionally upon “there being more than a preset amount of delivery time, the preset amount of delivery time being less than the amount of delivery time available to the content consumer,” as recited in each of independent claims 1, 35, and 37.

The second paragraph of *Pruss* cited by the Examiner states:

In block 206, optionally, a user type is determined for the mobile user. Examples of user types include nonprepaid user, normal volume base prepaid user, normal *time based prepaid user*, normal volume & *time based prepaid user*, premium volume based prepaid user, premium *time based prepaid user*, premium volume & *time based prepaid user*, etc. Determining a user type may be useful for external applications.¹⁴

Thus, *Pruss* discusses a user type that includes a “time based prepaid user.” However, the mere discussion in *Pruss* of a “time based prepaid user” does not teach or suggest performing one or more operations conditionally upon “there being more than a preset amount of delivery time, *the preset amount of delivery time being less than the amount of delivery time available to the content consumer*,” as recited in each of independent claims 1, 35, and 37 (emphasis added).

The third paragraph of *Pruss* cited by the Examiner states:

In block 208, a service request is received. In certain embodiments, either the mobile user issues an explicit request for a service, or a service in the user profile is automatically requested or a network based agent acting on behalf of the mobile user issues an explicit request for a service. In block 210, explicit service authorization is performed. *Block 210 may involve determining whether the mobile user has sufficient prepaid credit to permit granting the service to the user*, determining an allowed quota value in terms of service time or volume, etc. Assuming that service authorization is successful, accounting for the service starts in block 211. Block 211 may involve generating accounting records that reflect user consumption of services, audit records, etc.¹⁵

Thus, *Pruss* discusses determining whether a mobile user has sufficient prepaid credit to permit granting a service to the user. However, permitting the granting of a service to a user based on whether the mobile user has sufficient prepaid credit does not teach or suggest performing one or more operations conditionally upon “there being more than a preset amount of

¹⁴ *Pruss* at [0067] (emphasis added).

¹⁵ *Pruss* at [0068] (emphasis added).

delivery time, *the preset amount of delivery time being less than the amount of delivery time available to the content consumer*,” as recited in each of independent claims 1, 35, and 37 (emphasis added).

As stated above, the Examiner relied solely on *Pruss* to support the allegation that *Pruss* teaches or suggests a recitation similar to the recitation discussed above with respect to independent claims 1, 35, and 37. However, as discussed above, *Pruss* does not teach or suggest at least the above recitation of each of independent claims 1, 35, and 37. Therefore, because none of the references (*Hans*, *Pruss*, or *Seago*) cited by the Examiner discloses at least the above recitation of each of independent claims 1, 35, and 37, no combination of the references cited by the Examiner can or does teach or suggest the above recitation of each of independent claims 1, 35, and 37. Accordingly, independent claims 1, 35, and 37, are patentable and should be allowed.

Furthermore, each of independent claims 17, 28, and 36, as amended, recites, in part, performing one or more operations when:

the remaining available delivery time exceeds a preset amount of time, the preset amount of time being less than the amount of delivery time available to the content consumer.

This recitation of each of independent claims 17, 28, and 36 is analogous to the recitation of each of independent claims 1, 35, and 37 discussed above. Therefore, each of independent claims 17, 28, and 36 is non-obvious for at least the same reasons discussed above with respect to independent claims 1, 35, and 37.

Moreover, any claim depending from a non-obvious independent claim is also non-obvious for at least the same reasons as the claims from which they depend.¹⁶ Therefore, claims 3-5, 7-16, which depend on independent claim 1, claims 19-27, which depend on independent claim 17, and claims 29-33, which depend on independent claim 28, are non-obvious for at least the same reasons discussed above with respect to independent claims 1, 17, and 28. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims

¹⁶ See MPEP § 2143.03.

1, 3-5, 7-17, 19-33, and 35-37 under 35 U.S.C. § 103(a). Furthermore, each of the dependent claims may be patentable for its own reasons.

The Examiner also rejected claims 2, 6, and 18 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Hans* in view of *Pruss*, in view of *Seago*, and in view of U.S. Patent Application Publication No. 2003/0217163 A1 to Lagerweij et al. (hereinafter “*Lagerweij*”).¹⁷ However, as discussed above, any claim depending from a non-obvious independent claim is also non-obvious for at least the same reasons as the claims from which they depend.¹⁸ Therefore, claims 2, 6, which depend on independent claim 1, and claim 18, which depends on independent claim 17, are non-obvious for the same reasons discussed above with respect to independent claims 1 and 17. Accordingly, Applicant respectfully requests that the examiner withdraw the rejection of claims 1, 3-5, 7-17, 19-33, and 35-37 under 35 U.S.C. § 103(a). Furthermore, each of the dependent claims may be patentable for its own reasons.

¹⁷ Office Action at 10.

¹⁸ See MPEP § 2143.03.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 660-2016 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 26th day of August, 2010.

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